Attorney Docket No.: 1400-1072D2
Client Ref. No.: 10072-US-DIV2

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of:	§	
	§	
Lazaridis et al.	§	Confirmation No.: 7167
	§	
Application No.: 09/783,726	§	Art Unit: 2448
	§	
Filed: February 14, 2001	§	Examiner: Aaron Strange

For: SYSTEM AND METHOD FOR PUSHING INFORMATION FROM A HOST SYSTEM TO A MOBILE DATA COMMUNICATION DEVICE

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

APPEAL BRIEF UNDER 37 C.F.R. § 41.37

Pursuant to 37 C.F.R. § 41.37, Applicant (hereinafter "Appellant") hereby submits this appeal brief in the above-captioned patent application, wherein an Advisory Action was issued on June 4, 2012.

This appeal is from the decision of Examiner Aaron Strange, Art Unit 2448, rejecting claims 102-109, 111, 112 and 122-129 in

the present patent application, as set forth in the Final Office Action dated April 13, 2012.

I. REAL PARTY IN INTEREST

The real party in interest of the present patent application is Research In Motion Limited, a corporation organized under the laws of the Province of Ontario, CANADA, having a place of business at 295 Phillip Street, Waterloo, Ontario, CANADA, N2L 3W8.

II. RELATED APPEALS AND INTERFERENCES

The present patent application was referenced in a Complaint filed in the United States District Court - Southern District Court of New York, with respect to a civil action styled *Mahmood v. Research In Motion Ltd.,* Civil Action No. 12-cv-00899-KBF, on February 3, 2012. This Complaint was submitted by Appellant in an Information Disclosure Statement filed on March 16, 2012.

Interference No. 105,700, Lazaridis v. Eggleston (Administrative Patent Judges: Jameson Lee, Richard Torczon and Sally C. Medley), which was declared on July 23, 2009 and where a Decision and Judgment on Merits were entered on May 2, 2011,

involved U.S. Patent No. 6,219,694 to which the present patent application claims priority.

Appellant is not aware of any other prior and/or pending appeals, interferences, or judicial proceedings which may be related to, directly affect or be directly affected by or otherwise have a bearing on the Board's decision in this pending appeal.

III. STATUS OF CLAIMS

Claims 102-109, 111, 112 and 122-129 are pending, of which claims 102 and 122 are in independent form.

Claims 1-101, 110 and 113-121 have been cancelled previously.

Claims 102-104, 106-109, 111, 112, 122 and 124-129 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over AirMobile (Software for Lotus cc:Mail Wireless, Communication Client Guide, Motorola, 1995; hereinafter *AirMobile Client*) in view of U.S. Patent No. 5,764,899 to Eggleston et al. (hereinafter *Eggleston*).

Claims 105 and 123 are rejected under 35 U.S.C. § 103(a) over AirMobile Server (AirMobile Wireless Software for Lotus

cc:Mail, Communication Server Guide, Motorola, 1995; hereinafter *AirMobile Server*) in view of *AirMobile Client* and *Eggleston* and in further view of U.S. Patent No. 6,289,105 to Murota (hereinafter *Murota*).

Claims 102-109, 111, 112 and 122-129 are on appeal.

IV. STATUS OF AMENDMENTS

Appellant filed a response on May 23, 2012 to address the 35 U.S.C. § 112, first paragraph, rejections set forth in the April 13, 2012 Final Office Action. The Advisory Action of June 4, 2012 indicated that Appellant's amendments and argument of the May 23, 2012 response were sufficient to overcome the 35 U.S.C. § 112, first paragraph, rejections.

All amendments submitted prior to the April 13, 2012 Final Office Action have been entered.

A copy of the claims on appeal is attached hereto as an Appendix.

V. SUMMARY OF CLAIMED SUBJECT MATTER

A concise explanation of the subject matter defined in each of the appealed independent claims is set forth in this Section, including appropriate references to the specification, e.g., by page/line number(s) and/or by paragraph number(s), reference numerals in drawings, detailed description, etc., based on U.S. Patent Application Publication No. 2001/0005857 corresponding to the instant patent application. These specific references are examples of particular elements of the drawings for certain embodiments of the claimed invention, and the claims are not limited solely to the elements corresponding to the applied reference numerals.

Independent claim 102 is directed to an embodiment of a method of pushing user data items from a messaging host system to a wireless mobile data communication device that is associated with a user having a mailbox at the messaging host system. See, e.g., FIGS. 2 and 4 as well as related description at paragraphs [0011], [0040] and [0053]-[0055]. The claimed embodiment comprises receiving notifications at a redirector component (e.g., redirection software 12 in FIG. 2) indicating receipt of user data items by the messaging host system (e.g., an email message server such as Microsoft® Exchange Server, see paragraph

[0040]), wherein the notifications are received in response to receipt of the user data items at the messaging host system. See, e.g., paragraphs [0033] and [0040]. The user data items are processed by the redirector component 12 to add address information associated with the wireless mobile data communication device (e.g., mobile computer 24 in FIG. 2). See, e.g., paragraphs [0037] and [0043]. The claimed embodiment further comprises causing to continuously redirect the user data items to the wireless mobile data communication device 24 over a wireless network (e.g., network 22 in FIG. 2) without establishing a connection therewith. See, e.g., paragraphs [0004], [0007], [0018] and [0055].

Independent claim 122 is directed to an embodiment of a non-transitory computer-accessible medium having a sequence of instructions (e.g., redirection software 12 in FIG. 2) which, when executed by a processing entity, effectuate pushing of user data items from a messaging host system to a wireless mobile data communication device that is associated with a user having a mailbox at the messaging host system. See FIG. 4 which illustrates exemplary functionality of an implementation of redirection software 12 in a flowchart; see also paragraphs [0044] and [0046] that discuss additional functional aspects of

redirection software program 12. The claimed embodiment comprises a code portion for processing notifications received from the messaging host system that are indicative of receipt of user data items by the messaging host system (e.g., an email message server such as Microsoft® Exchange Server, see paragraph [0040]), wherein the notifications are received in response to receipt of the user data items at the messaging host system. See, e.g., paragraphs [0033] and [0040]. A code portion is included for processing the user data items to add address information associated with the wireless mobile data communication device (e.g., mobile computer 24 in FIG. 2). See, e.g., paragraphs [0037] and [0043]. The claimed embodiment further comprises a code portion for causing to continuously redirect the user data items to the wireless mobile data communication device 24 over a wireless network (e.g., network 22 in FIG. 2) without establishing a connection therewith. See, e.g., paragraphs [0004], [0007], [0018] and [0055].

VI. GROUND(S) OF REJECTION TO BE REVIEWED ON APPEAL

A. Claims 102-104, 106-109, 111, 112, 122 and 124-129 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *AirMobile Client* in view of *Eggleston*.

B. Claims 105 and 123 are rejected under 35 U.S.C. § 103(a) over *AirMobile Server* in view of *AirMobile Client* (cumulatively referred to as *AirMobile*) and *Eggleston* and in further view of *Murota*.

VII. ARGUMENT

1. *AirMobile* system is a polling-based message forwarding system and as such it cannot be characterized as a push architecture encompassed in the claimed embodiments.

Embodiments of the present patent application are broadly concerned with pushing information from a host system to a mobile data communication device. Innovative features of the embodiments may be better appreciated in view of a "push paradigm" disclosed in the patent application, for example, at paragraphs [0003] and [0006]-[0008], reproduced below:

> [0003] Instead of warehousing (or storing) the user's data items at the host system and then "synchronizing" the mobile data communication device to data items stored at the host system when the mobile device requests that such items of information be communicated to it, the present invention employs a "push" paradigm that continuously packages and retransmits the user-selected items of information to the mobile data communication device in response to a triggering event detected at the host system. Wireless mobile data communications devices, especially those that can return a confirmation signal to the host that the pushed data has been received are especially well suited for this type of push paradigm.

> [0006] There remains a general need in this art for a system and method of **continuously pushing** user-selected data items (or certain portions of the selected data items) stored at a host system to a user's mobile data communication device. (Emphasis added)

> [0007] There remains a more particular need for such a system and method where user-selected data items are continuously **"pushed" from the host system** to the mobile data communication device upon the occurrence of one or more user-defined triggering events. (Emphasis added)
>
> [0008] There remains an additional need for such a system and method that provides flexibility in the types and quantities of user data items **that are pushed from the host system** to the mobile data communication device and that also provides flexibility in the configuration and types of events that can serve to trigger the redirection of the user data items. (Emphasis added)

In accord with the push paradigm described in the present patent application, base claim 102 and 122 are concerned with "pushing user data items from a messaging host system". In contrast, however, the system described in the *AirMobile* references is a polling-based forwarding scheme as discussed below.

The *AirMobile Server* reference and its companion the *AirMobile Client* reference (cumulatively referred to as *AirMobile* references) are directed to an email forwarding scheme over a wireless network wherein two types of messaging delivery models are disclosed: (i) a "client poll" model and (ii) a so-called "server push" model. See page 30 of the *AirMobile Client* reference, under subsection heading "Messaging Models". The

"client poll" model involves polling from the user's standpoint, i.e., the user needs to poll the host system by sending a request on a periodic basis to effectuate delivery of email messages from the host system to the user's device. The "server push" model, on the other hand, does not require the user to constantly poll the host system to retrieve emails.

Although the *AirMobile Client* reference appears to define the "server push" model as one that does not involve polling from the standpoint of a user, it does not mean, however, that the *AirMobile* system is not a polling system. Specifically, the *AirMobile Server* reference provides that AirMobile (AM) server software is ***required to poll*** a user's inbox at the mail server at a predetermined scheduler cycle period. See page 23 of the *AirMobile Server* reference, at paragraph 1. Additionally, the AM server software is also required to poll the mail server at a predetermined inter-user time-out period. See page 23 of the *AirMobile Server* reference, at paragraph 2. In other words, the email forwarding scheme disclosed in the *AirMobile Server* and *Client* references is in fact a polling-based system that requires polling by the AM server software, although it is hidden from the user's perspective.

Accordingly, Appellant respectfully submits that the scheme disclosed in the *AirMobile Server* and *Client* references (which may be characterized as a "server push" model for marketing purposes but inherently and necessarily involves server polling,) does not teach or suggest the claimed "push" paradigm wherein a redirector component causes to **continuously** redirect the user data items **from the messaging host system** to the user's wireless mobile data communication device.

2. *AirMobile* system requires a wireless channel connection between the mobile client and the AM server for forwarding messages.

In the pending Final Office Action, the *AirMobile* system has been characterized as teaching delivery of messages to the mobile client "without maintaining a session". Although *AirMobile Client* discloses the phrase "without maintaining a session", it admits that the architecture of the *AirMobile* communication system involves a mobile client that is actually "connected". See page 30 under the sub-heading "**Connected** without maintaining a session" (emphasis added). In particular, the *AirMobile Client* reference discloses that an authenticated virtual wireless communication channel is established between a mobile client

(e.g., a laptop running the client software) and the server for downloading messages upon querying. Appellant respectfully submits that disregarding the term "Connected" while applying the phrase "without maintaining a session" against the pending base claims would be improper and arbitrary. Taken as a whole, accordingly, it is clear that *AirMobile* does not teach or suggest the feature of "causing to continuously redirect the user data items . . . without establishing a connection therewith" as claimed.

3. *Eggleston* also teaches a virtual session based communication architecture that requires a connection with the mobile client.

Eggleston is relied upon in the Final Office Action to cure the admitted deficiencies of *AirMobile*. Specifically, the Final Office Action stated as follows on page 6:

> While AirMobile discloses the invention substantially as claimed, it fails to specifically disclose that the user data items are "continuously redirected", **regardless of the availability of the wireless device.** (Emphasis added)
>
> Eggleston discloses a similar system for redirecting messages to a wireless device. Eggleston teaches continuously redirecting data items via a virtual session and identifies the procedure for

> removing a client from active status and stop attempting to deliver data as a process that is *"preferably* included in the VSM" (col. 7, ll. 37-40). **A preferable feature is not required, and one of ordinary skill in the art would have understood Eggleston's disclosure to mean that the system properly operate, albeit less efficiently, with this feature removed.** Therefore, Eggleston at least suggests a system where messages are continuously forwarded, regardless of the availability of the client device. Eggelston [*sic*] additionally discloses that messages are delivered "without establishing a connection session" (col. 7, ll. 10-14). (Emphasis in bold added)

As an initial matter, Appellant wishes to bring to the attention of the Board that the system of *AirMobile* and the system of *Eggleston* are essentially the same, with additional details and description set forth in *Eggleston* for purposes of the statutory requirements of a patent application. Further, *Eggleston* is owned by the same company that produced the *AirMobile* system. In *Eggleston*, a laptop computer 105 with a wireless modem 106 is operable as a mobile client that communicates with a "communication server" 110, which in turn is coupled to a user's "Post Office" host server 115. *AirMobile* describes the same system, using exactly the same terminology. *Eggleston* was filed in 1995, the same year that the *AirMobile* references are copyrighted. Two of the inventors on the *Eggleston* patent – Gene Eggleston and Mitch Hansen – are

referenced on numerous occasions in the *AirMobile* guides. Accordingly, it is Appellant's contention that the deficiencies of *AirMobile* also flow to *Eggleston*, notwithstanding the additional detail shown therein.

As a further initial matter, Appellant submits that the claimed feature in question recites "causing to continuously redirect the user data items to the wireless mobile data communication device over a wireless network without establishing a connection therewith" (see base claims 102 and 122), which does not recite the language "regardless of the availability of the wireless device". It would be a gross mischaracterization, therefore, to interpret the recited language "without establishing a connection therewith" to mean "regardless of the availability of the wireless device". Appellant's claim language simply requires that there is no requirement of establishing a connection with the wireless mobile data communication device for continuously redirecting user data items thereto. On the other hand, however, *Eggleston* requires establishing a connection with the mobile client in order for forwarding messages to it using a virtual session. Furthermore, *Eggleston* discloses preferably terminating the connection between the mobile client 105 and the communication server 110 where there is no activity or where the

mobile client is unavailable for some reason, for example, as will be set forth in detail below.

In *Eggleston*, communication server 110 includes a virtual session manager 230 and a query manager 231, and is coupled between a data network 130 and the Post Office host/server 115. See FIGS. 1 and 2. The virtual session manager 230 is provided for establishing and maintaining a virtual session communication path with the mobile station 105 and a session-oriented communication path with the host server 115. As described with respect to FIG. 2, which shows additional details of an exemplary communication server 220, the query manager 231 is designed to send requests to a mail server (i.e., Post Office server) to query for unprocessed messages.

FIG. 3 of *Eggleston* particularly illustrates a data transfer process involving a virtual session connection between the mobile client and the VSM for forwarding email from the post office server of *Eggleston*. At column 6, lines 23-57, *Eggleston* describes the initial necessary steps involved in this process:

> A process by which a VSM manages communications between client and host is illustrated in the flow chart embodiment of FIG. 3. This process typically begins with a user event, such as instantiation (forming) of a communications object at the client and sending a registration message (steps 301-302). Alternatively, the infrastructure could initiate the communications by

> sending a page or the like requesting the client to register (for example, when the client has registered with the wireless system but not yet requested registration with the communications server). In any event, once a registration message is received by the communications server, it preferably authenticates and otherwise qualifies the client, including sending a logon/registration message to the host for its authentication of the client (steps 303-305). Upon successful authentication, the communications server instantiates a client object (CO) for the communications session including client parameters retrieved from an inactive client parameter store, as modified by the user in his registration or subsequent messages (step 306). These parameters include at a minimum client and host identifiers, but may also include additional preferences based on the type of communications involved. Also, the registration and authentication process can be handled by the VSM or alternatively by another appropriately programmed entity of the communications server. Following instantiation at the server, a response message, e.g., a further registration message, is sent to the client, and an acknowledgment (ACK) returned to the server; both client and server then retain the instantiated objects as fully qualified, and start session timers (steps 307-309). **At this point a virtual session has been established between the client and the VSM, and a regular session established between the VSM and host computer.** If the registration is not successful, then any instantiated object is deleted, with the client returned to an inactive status. (Emphasis added)

Based on the foregoing, it is clear that the mobile client 105 is first required to communicate with the communications server's VSM and engage in a registration/authentication process therewith. Upon successful authentication, a virtual session is established and maintained between the mobile client (see steps

302-307) and the communications server, **until it is torn down**, whereupon the query manager 231 is programmed to send query objects at predetermined intervals for each application being run by each active mobile station requesting unprocessed data for that user from the Post Office server. Accordingly, Appellant respectfully submits that although at column 2, lines 51-58, *Eggleston* recites "maintaining a sessionless communication path with a first data processing device (e.g., a mobile client)", it should be understood that there is in fact a virtual session that is established for connecting with the communications server whereby a registration/authentication process and subsequent message downloading can take place with the mobile client.

While it may be true that *Eggleston* refers to "a sessionless mode" for data transfer to the mobile client, it should be appreciated that the so-called sessionless mode data transfer is implemented in order to reduce connection costs to a minimum. It does not mean that *Eggleston* does away altogether with a connection having virtual session with the mobile client. The passage at column 6, line 58 to column 7, line 22, reproduced below, is particularly germane:

> Upon establishing the virtual session, a query is preferably generated by query manager requesting unprocessed data for the user, and the VSM forwards the

> query to the host (step 320). In the case of email, e.g., this might include generating a request message for all unread mail in the users post office box. The post office then checks for new mail received, and forwards all such mail to the VSM (steps 321-322). Because the VSM has established a LAN session with the post office, these communications are performed relatively quickly, e.g., in accordance with the LAN's and host's typical processing for their current loading level. The VSM in turn forwards the data (i.e. mail) received via the virtual session transport (step 323) For example, in the case of FIG. 1 where PDN 130 is an ISDN (integrated services digital network) network connected to a CDPD wireless network, the mail would be appropriately packetized by the communications server and delivered via the serving BS 120 according to ISDN/CDPD system protocols. This can take up to several minutes or more for a moderately sized mail package. **However, since the data is being delivered in a sessionless mode, the amount of time the communication channel (including the more expensive wireless communication channel portion, as well as the portion via PDN 130) is tied up is kept to a minimum.** This also translates into a significant cost savings for the user, since the user is only charged on a per packet basis for mail when it is actually transported, and doesn't have to pay for a prolonged session to keep connected to the post office in order to receive new mail Finally, upon receipt by the client, appropriate acknowledgments are sent and the post office box updated, e.g., by marking the mail as read or processed (steps 324-326). (Emphasis added)

The fact that the foregoing passage specifically refers to expensive wireless communication channels as well as packet data network connections, and the need to reduce the portion of the network **tied up** for communicating with the mobile client to a

minimum, should indicate that there is a virtual session connection between the mobile client and the communication server for forwarding messages. Appellant therefore submits that it would be mischaracterization to read the phrase "in a sessionless mode" of *Eggleston* as being the same as or equivalent to the claimed feature reciting "without establishing a connection herewith".

Furthermore, the language at column 7, lines 33-58, makes it clear that in order to reduce the connection costs and inefficient use of resources, a timer mechanism may preferably be included to monitor the activity of the virtual session connection between the mobile client 105 and communication server 110. This passage is reproduced below:

> Further, it is an inefficient use of resources to continue querying a host or attempting to deliver data when the client is no longer receiving at its remote location (occurring, e.g., when the client leaves a coverage area, or the user turns off its modem or processor). Thus, **a process for either maintaining the client in an active status, or removing the client from active status in response to an event, is also preferably included in the VSM. One such process is to utilize timers at both client and VSM to determine when a virtual session is no longer active.** The timers are first set upon registration, and are subsequently reset after each data exchange (steps 327-336). If no data exchange occurs within a predetermined period of time, say 20 minutes, both client and VSM would remove the client qualification (i.e., destroy the client object

> for the communication session) and, if desired, mark the client as being in an inactive status (steps 337-340). The VSM would also forward a logoff message to the host step 341). In order to avoid an undesired time out, the client is preferably configured to send a short message after a predetermined period since the last data exchange, sufficiently prior to the time at which the timers elapse so that the VSM can receive it. Otherwise, if there are only intermittent data exchanges, the client may be required to frequently re-register; this in turn means the client will not be notified of outbound data until the client re-registers and is again coupled via the virtual session manager. (Emphasis added).

It is clear that the preferably included timer mechanism described above is used to terminate the virtual session connection (by destroying the client object for the communication session) where the mobile client is unavailable or there are no new email messages to be downloaded, so that the connection costs and resource usage are kept to a minimum. That a timer mechanism/process for connection termination is a preferable feature simply means that if that mechanism/process were not included (since it is not required), there would be inefficient resource usage and concomitantly higher connection costs (because the client continues to be in active status and the virtual session connection is still up, but there is no activity on it). On the other hand, if the mobile client is switched off or outside a coverage area, it will not be able to register and

maintain an active state with the VSM, resulting in lack of a virtual session connection. No messages can therefore be forwarded to the mobile client. It should therefore be perfectly clear that only when there is an active virtual session connection with the mobile client, can the *Eggleston* system forward the messages to it. In addition, the fact that *Eggleston* describes a more efficient embodiment by preferably including a timer-based connection termination mechanism should lead to the inference that the message forwarding system of *Eggleston* actually requires establishing a connection to the mobile client for forwarding messages thereto via a virtual session.

4. Appellant's Experts agree that the *AirMobile* communication system requires a connection with the server and as such is incapable of continuous redirection of user data items as claimed.

Appellant further wishes to bring to the attention of the Board the Andrew Seybold Declaration provided by the assignee of the present patent application in a recently concluded interference between U.S. Patent No. 6,219,694 (commonly owned by the assignee of the instant patent application) and Application No. 09/095,325 (the real party in interest being Motorola, Inc.), referenced in the section "RELATED APPEALS AND INTERFERENCES"

above, to support the position that the *Eggleston/AirMobile* communication system requires a connection with the mobile client for forwarding email messages. This interference is styled Lazaridis v. Eggleston, Patent Interference 105,700 (Administrative Patent Judges: Jameson Lee, Richard Torczon and Sally C. Medley), the record of which may be found at https://acts.uspto.gov/ifiling.

The Seybold Declaration (Substitute Declaration of Andrew M. Seybold, Document No. 196) was filed on June 7, 2010 in the above-referenced interference and was subsequently submitted by Appellant as a Non-Patent Literature reference (NPL #19) in an Information Disclosure Statement in the present patent application on November 2, 2011. At paragraphs 20-24, the Seybold Declaration states the following with respect to the AirMobile client's operation:

> 20. I witnessed a mobile communications device connecting over the ARDIS wireless data network to a desktop PC.
>
> 21. The AirMobile application was running on the mobile communications device as well as on the desktop PC.
>
> 22. The mobile communications device **connected to the desktop PC over the wireless network using**

> **AirMobile.** A password was required to make the connection. (Emphasis added)
>
> 23. Once the connection was made, the mobile communications device acted as a remote terminal—that is, whatever was on the desktop PC screen in the way of data, could be accessed and changed by the mobile communications device.
>
> 24. A message sender used the mobile communications device to compose and send a message with AirMobile by opening the email client on the desktop PC. The message sender filled in the "to" field, the "subject" field, and the "message" field using the mobile communications device.

It is therefore clear that the *AirMobile* communication system witnessed by Appellant's expert demonstrates the necessity of establishing a connection with the computer server for the mobile client in order that the messages can be downloaded or forwarded to it.

Appellant also wishes to bring to the attention of the Board the Karp Declaration provided by the owner of the present patent application in the Interference 105,700, identified hereinabove, to support the position that the *Eggleston/AirMobile* communication system is incapable of continuously redirecting email messages to a mobile client.

The Karp Declaration (Declaration of Brad Karp, Document No. 274) was filed on June 7, 2010 in the above-referenced interference and was subsequently submitted by Appellant as a Non-Patent Literature reference (NPL #20) in the November 2, 2011 Information Disclosure Statement. At paragraphs 43-45, the Karp Declaration states the following in describing the *Eggleston* architecture:

> 43. Eggleston '899 confirms that once the virtual session has been terminated, "the client will not be notified of outbound data until the client re-registers and is again coupled via the virtual session manager." Ex. 1001 at 7:55-58. This statement further supports that Eggleston '899 only sends messages to a user in response to a request, generated by the query manager, after the mobile client has registered with the VSM and the VSM has logged onto the host system. Messages are not continuously redirected or pushed as recited in Lazaridis's claims, and **Eggleston '899 acknowledges that a user will not receive any messages absent an active connection to the VSM and login to the post office.** (Emphasis added)
>
> 44. Eggleston '899 seeks to reduce costs by timing out a session once a threshold of usage is reached. After reaching the threshold, Eggleston '899 "terminat[es] the current session and prevent[s] further sessions until additional use limit time/charge is authorized." Eggleston Ex. 1001 at 14:34-36. **Eggleston '899 therefore ends the session and stops transmitting data to a user, meaning the user will not receive any new email messages. I do not consider a system that intentionally terminates transmission of messages in this way to be one that "continuously" redirects messages.** (Emphasis added)

45. Accordingly, I conclude that Eggleston '899 does not teach or suggest "continuously redirecting" messages as recited by Lazaridis independent claim 1. **More appropriately, Eggleston '899 discloses the type of register-and-login-based querying system that Lazaridis overcame.** (Emphasis added)

With respect to the feature of "continuous redirection", claim 1 of the involved Patent No. 6,219,694 recites as follows:

1. A method of redirecting messages between a host system and a mobile data communication device, comprising the steps of:

configuring one or more redirection events at the host system;

detecting that a redirection event has occurred at the host system and generating a redirection trigger;

receiving messages directed to a first address at the host system from a plurality of message senders;

in response to the redirection trigger, **continuously redirecting** the messages from the host system to the mobile data communication device;

receiving the messages at the mobile data communication device;

generating reply messages at the mobile data communication device to be sent to the plurality of message senders and transmitting the reply messages to the host system;

receiving the reply messages at the host system and configuring address information of the reply messages such that the reply messages use the first address associated with the host system as the originating address, wherein messages generated at either the host system or the mobile data communication device share the first address; and

transmitting the reply messages from the host system to the plurality of message senders.

Appellant respectfully submits it is essentially the same feature of "continuous redirection" that is also currently recited in pending base claims. Accordingly, the *Eggleston/AirMobile* communication system cannot reasonably be characterized as a communication system that can support continuous redirection of user data items as set forth in the claims on appeal.

At least for the foregoing reasons, Appellant submits that the cumulative teachings of *AirMobile* and *Eggleston* fail to teach or suggest all the limitations of base claims 102 and 122 as currently constituted. Reliance on the remaining tertiary reference, i.e., *Murota*, is also of no avail since it is merely concerned with encryption of emails and as such fails to cure the cumulative deficiencies of the *AirMobile* and *Eggleston* references.

All pending claims of the present patent application as currently constituted are therefore believed to be patentably distinguishable over the applied art of record.

CONCLUSION

In view of the foregoing discussion, Appellant respectfully submits that the rejection of pending claims 102-109, 111, 112 and 122-129 is not proper. Accordingly, Appellant respectfully requests that the rejection of the pending claims be overturned by the Board, and that the present patent application be allowed to issue as a patent with all pending claims.

Respectfully submitted,

Dated: June 27, 2012

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VIII. APPEALED CLAIMS - APPENDIX

102. A method of pushing user data items from a messaging host system to a wireless mobile data communication device that is associated with a user having a mailbox at the messaging host system, the method comprising:

receiving notifications at a redirector component indicating receipt of user data items by the messaging host system, wherein the notifications are received in response to receipt of the user data items at the messaging host system;

processing the user data items by the redirector component to add address information associated with the wireless mobile data communication device; and

causing to continuously redirect the user data items to the wireless mobile data communication device over a wireless network without establishing a connection therewith.

103. The method as recited in claim 102 wherein the redirector component is operating on the messaging host system.

104. The method as recited in claim 102 wherein the redirector component is operating on a host system that is coupled to the messaging host system via a network.

105. The method as recited in claim 102 further comprising encrypting the user data items.

106. The method as recited in claim 102 further comprising compressing the user data items.

107. The method as recited in claim 102 further comprising encoding the user data items.

108. The method as recited in claim 102 further comprising encoding the user data items using Multipurpose Internet Mail Extensions.

109. The method as recited in claim 102 wherein the user data items comprise email messages.

111. The method as recited in claim 102 wherein the user data items are continuously redirected to the wireless mobile data communication device over the wireless network via a wireless gateway disposed between a wide area network and the wireless network.

112. The method as recited in claim 102 further comprising the step of storing the user data items at a data store associated with the messaging host system.

122. A non-transitory computer-accessible medium having a sequence of instructions which, when executed by a processing entity, effectuate pushing of user data items from a messaging host system to a wireless mobile data communication device that is associated with a user having a mailbox at the messaging host system, the non-transitory computer-accessible medium comprising:

a code portion for processing notifications received from the messaging host system that are indicative of receipt of user data items by the messaging host system, wherein the notifications are received in response to receipt of the user data items at the messaging host system;

a code portion for processing the user data items to add address information associated with the wireless mobile data communication device; and

a code portion for causing to continuously redirect the user data items to the wireless mobile data communication device over a wireless network without establishing a connection therewith.

123. The non-transitory computer-accessible medium as recited in claim 122 further comprising a code portion for encrypting the user data items.

124. The non-transitory computer-accessible medium as recited in claim 122 further comprising a code portion for compressing the user data items.

125. The non-transitory computer-accessible medium as recited in claim 122 further comprising a code portion for encoding the user data items.

126. The non-transitory computer-accessible medium as recited in claim 122 further comprising a code portion for encoding the user data items using Multipurpose Internet Mail Extensions.

127. The non-transitory computer-accessible medium as recited in claim 122 wherein the user data items comprise email messages.

128. The non-transitory computer-accessible medium as recited in claim 122 further comprising a code portion for storing the user data items in a data store associated with the messaging host system.

129. The non-transitory computer-accessible medium as recited in claim 122 wherein the user data items are continuously redirected to the wireless mobile data communication device over the wireless network via a wireless gateway disposed between a wide area network and the wireless network.

IX. EVIDENCE - APPENDIX

Other than the applied art and the Declarations referenced in the ARGUMENT section (Section VII) set forth above, which Declarations are attached hereto, none is supplied herewith.

X. RELATED PROCEEDINGS - APPENDIX

Except as set forth in Section II above, there are no other related proceedings.

Appendix

To

Section IX

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Mihal **Lazaridis** and Gary P. Mousseau
Junior Party
(Patent 6,219,694)

v.

Gene **Eggleston**, Mitch Hansen,
and Richard Krebs
Senior Party
(Application 09/095,325)

Patent Interference 105,700 (JL)
Technology Center 2100

SUBSTITUTE DECLARATION OF ANDREW M. SEYBOLD

LAZARIDIS EXHIBIT 2029
Lazaridis v. Eggleston
Contested Case 105,700

I, Andrew M. Seybold declare that:

1. My name is Andrew M. Seybold and I reside at 315 Meigs Road, A-267, Santa Barbara, CA 93109.

2. I have been retained by Research In Motion, Ltd. ("RIM") and am being compensated at my normal consulting rate of $600.00 per hour for my time spent in preparing this declaration.

3. I am president and CEO of Andrew Seybold, Inc. I have more than 40 years of experience in the wireless, computer, and mobile computing space. During the course of my career, I have conceptualized, designed, and deployed wireless communications networks for numerous public safety and first responder agencies around the nation, and co-developed the first paramedic communications radio for the transmission of voice and EKG signals from an incident site to hospital emergency rooms. In the commercial sector, I have worked in the wireless space with wireless network operators, handset and device vendors, and software applications providers from around the world.

4. I have written thousands of articles about the convergence of wireless and mobile computing, publishing them both under my own brand (Andrew Seybold, Inc.) and for leading industry publications such as *Wireless Week, Mobile Enterprise Magazine, Fierce Wireless, Mobile Enterprise Magazine, Forbes*, and others. I have also published a number of books on technology (see Appendix A) and have given hundreds of speeches, including keynote addresses for major conferences around the world.

5. I have been involved in the Wireless email segment of the wireless industry since its inception, first working with RadioMail and other companies and then advising hardware and software companies deploying products in the early 1990's.

6. As can be seen from my CV (Appendix A), I am a member of the Radio Club of America and was elevated to Fellow in that organization in 2000 for my work in the field of wireless data. I am a commercial member of the Associated Public Safety Communications Officers Association and have served on many communications committees and with many organizations providing wireless expertise to a number of private and governmental agencies.

7. During the 1990's and beyond, I was deeply involved in the birth of wireless email systems, services, and offerings. I provided consulting services and product evaluations for a large number of companies engaged, or about to become engaged in the use of wireless technologies for the transmission and reception of email. Some of my clients, in the 1990's included Microsoft, Motorola, RadioMail, Hewlett Packard, Dell Computer, IBM, Visto, Research In Motion, Compaq Computer, Nettech, and others.

8. I was the co-founder and Chairman of the Board of the Portable Computer and Communications Association in the early 1990's. This organization developed a number of standards for the use of wireless devices communicating with existing land based servers, desktops, and data services. In 1994, The Wall Street Journal devoted a frill page to a story about me, my contributions to the wireless data industry, and my acknowledged leadership role in the wireless industry.

9. Today I am viewed, by many, as one of the "fathers" of wireless data services around the world, and continue to write, educate, and consult in this area. My company, Andrew Seybold, Inc., has clients around the globe and continues to enjoy a reputation for pushing the wireless industry forward.

10. In this declaration, I provide details regarding my knowledge of Motorola's AirMobile Software Program relating to a Comdex trade show.

11. In November of 1994 (14-18th), I attended the Comdex Fall Conference and exposition in Las Vegas, Nevada, as was my normal practice.

12. Comdex was one of the largest commercial trade shows in the United States for electronics. Tens of thousands of people attended Comdex.

13. Comdex brought together press, retailers, and manufacturers of a variety of electronic products.

14. Because Comdex received widespread coverage, many companies used it as the forum to announce, display, and demonstrate new products.

15. I attended Comdex as press to review new products.

16. While at Comdex I visited the Motorola Display areas.

17. In one of Motorola's display areas, Motorola was displaying and demonstrating:

- Two-way pagers designed for MTeI, MobileComm, and other paging companies
- Motorola PC Card Wireless Modem (PCMCIA form factor)
- The Envoy handheld for the ARDIS Network; and
- A new software product called AirMobile

18. I observed demonstrations of all of these products. I did not sign a confidentiality agreement before viewing the demonstrations, and the demonstrations were openly conducted so that patrons attending Comdex could see how Motorola's new products operated.

19. To the best of my recollection, Motorola's AirMobile software demonstration was set up so as to demonstrate that a mobile communications device could be connected via a wireless connection to a desktop PC.

20. I witnessed a mobile communications device connecting over the ARDIS wireless data network to a desktop PC.

21. The AirMobile application was running on the mobile communications device as well as on the desktop PC.

22. The mobile communications device connected to the desktop PC over the wireless network using AirMobile. A password was required to make the connection.

23. Once the connection was made, the mobile communications device acted as a remote terminal—that is, whatever was on the desktop PC screen in the way of data, could be accessed and changed by the mobile communications device.

24. A message sender used the mobile communications device to compose and send a message with AirMobile by opening the email client on the desktop PC. The message sender filled in the "to" field, the "subject" field, and the "message" field using the mobile communications device.

25. The e-mail was sent from the desktop PC to a second desktop PC in Motorola's booth.

26. The message appeared on the second desktop as if it originated from the message sender's desktop.

27. An e-mail was sent from the second desktop back to the desktop PC.

28. The mobile communications device used AirMobile to re-connect to the desktop PC, and the incoming e-mail was available to be read on the mobile communications device.

29. I have reviewed a series of press release articles, Exhibits 2031; 2032; 2034; 2035; 2036; 2037; 2038; 2039; 2040; 2041; 2042; 2043; 2044; 2053; 2054; 2055, which describe Motorola's release of AirMobile at Comdex.

30. The description of AirMobile in the press release articles is how I recall the product that I saw demonstrated at Comdex.

31. The statements made herein regarding the operation of the Airmobile are based on my personal knowledge and observations at the November 1994 Comdex trade show.

32. I declare that the foregoing is true and correct to the best of my knowledge.

33. In signing this declaration, I understand that the declaration will be filed as evidence in a contested case before the Board of Patent Appeals and Interferences of the United States Patent and Trademark Office. I acknowledge that I may be subject to cross examination in the case and that cross examination will take place within the United States. If cross examination is required of me, I will appear for cross examination within the United States during the time allotted for cross examination.

34. I declare that all statements made herein of my knowledge are true and that all statements made on information and belief are believed to be true and that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and may jeopardize the validity of the patent application to which they are directed or any patent issuing thereon.

Dated: December 2, 2009

Submitted by:

Andrew M. Seybold, Sr.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Mihal **Lazaridis** and Gary P. Mousseau
Junior Party
(Patent 6,219,694)

v.

Gene **Eggleston**, Mitch Hansen,
and Richard Krebs
Senior Party
(Application 09/095,325)

Patent Interference 105,700 (JL)
Technology Center 2100

DECLARATION OF BRAD KARP

I, Brad Karp, Declare As Follows:

1. My name is Brad Karp. I currently reside at Flat D, 26 Bloomsbury Sq., London WC1A 2PJ, UK.

I. Subject Matter of This Declaration

2. I have read and understand the written descriptions and drawings of U.S. Patent No. 6,219,694 ("the '694 patent"), U.S. Patent Application No. 09/095,325 ("the Eggleston application"), and U.S. Patent No. 5,764,899 ("Eggleston '899"). I understand that the '694 patent is assigned to RIM and the Eggleston application and Eggleston '899 are assigned to Motorola. I have been advised that RIM's '694 patent and Motorola's Eggleston application are involved in an interference proceeding in the United States Patent and Trademark Office. In this Declaration, I offer my opinions regarding the patentability of Lazaridis's claims and the unpatentabilty of Eggleston's claims.

3. I have been retained by Research In Motion, Ltd. ("RIM") as an expert witness in this interference. I am being compensated at the rate of £300 per hour for my time. No part of my compensation depends on the outcome of these proceedings. The Department of Computer Science at University College London, where I am employed, received donations in the amount of approximately £18500 from RIM per year in 2008 and 2009. I have no financial interest in RIM or the Lazaridis patent.

II. Background and Qualifications

4. I earned a Bachelor of Science degree at Yale University in 1992, a Master of Science degree at Harvard University in 1995, and a Doctor of Philosophy degree at Harvard University in 2000, all in Computer Science.

5. After completing my Ph.D., I spent two years as a research staff member in the ICSI Center for Internet Research (ICIR) at the International Computer Science Institute (ICSI) at the University of California at Berkeley. Between 2002 and 2005, I held joint appointments as an Adjunct Assistant Professor of Computer Science at Carnegie Mellon University and as a Senior Staff Researcher at Intel Research Pittsburgh, the research laboratory on Carnegie Mellon's campus. Today I am a Reader in Computer Systems and Networks--a British academic rank equivalent to tenured Associate Professor in the US academic rank system--in the Department of Computer Science at University College London (UCL) in the United Kingdom.

6. Throughout my career, my research interests have been in networking, including a strong interest in wireless networking. I have long had a detailed familiarity with the workings of Internet email systems; I first learned to configure the sendmail mail processing software in 1990, and as part of the service to my lab at Harvard typical for graduate students, I configured sendmail on dozens of computers between 1993 and 2000.

7. I have published 20 peer-reviewed papers in the most selective publication venues in networking and computer systems, and am invited to serve regularly on the program committees responsible for peer review for these elite venues, including ACM SIGCOMM, ACM MobiCom, USENIX NSDI, and USENIX/ACM OSDI. In 2005, the Royal Society (the national academy of science in the United Kingdom) honored me with a Royal Society-Wolfson Research Merit Award, given to attract the world's leading scientists to academic posts in the UK.

8. My curriculum vitae is attached hereto and includes a more detailed summary of my background, experience, and publications.

III. The Perspective of One of Ordinary Skill in the Art

9. I believe the level of ordinary skill in the relevant art in 1994-1998 would best be defined as an engineer with a bachelor of science degree in electrical engineering (including classes in computer systems and software engineering) or computer science (with classes in data communications) and two to four years of educational or industry experience in electronic communications (including computer systems and software engineering). The more formal education one has, the less industry experience needed to attain an ordinary level of skill. I was a Skilled Artisan in the relevant art in 1994-1998.

IV. Eggleston '899 Does Not Anticipate Lazaridis '694

10. I understand that a reference must show the identical invention in as complete detail as is in the claim to anticipate.

11. I understand that a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.

12. I understand that to inherently describe a missing limitation, a patent disclosure must necessarily and unavoidably teach the missing limitation.

13. I understand that inherency may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.

14. I have reviewed U.S. Patent No. 5,764,899 to Eggleston et al. ("Eggleston '899"), Mr. Friend's declaration, and Lazaridis '694, and conclude that Eggleston '899 does not disclose—expressly or inherently—the combination recited by Lazaridis's claims.

"configuring address information"

15. All of Lazaridis's independent claims require configuring address information after receipt at a redirector component or host system. For example, claim 28 recites "receiving a message . . . at a redirector component associated with a host system" and then "configuring address information of the received message such that the received message uses the message sender's first address as the address originating the message, wherein messages generated at either the mobile data communications device or host system share the message sender's first address." Ex. 2001 at 17:33-45. I disagree with Mr. Friend's assertion that Eggleston '899 discloses "configuring address information," as required by Lazaridis's claims 1-36.

a. Addressing in Eggleston '899 and Mr. Friend's Analysis

16. Eggleston '899 does not disclose where or how to configure email addresses. Mr. Friend rests his conclusion that Eggleston '899 discloses "configuring address information" after receipt at a redirector component or host system on the premise that Eggleston '899 discloses a single-address system. Ex. 1004 at 8-11. I disagree for two reasons: first, regardless of whether Eggleston '899 is a single- or two-address system, it does not necessarily follow that Eggleston '899 configures address information after receipt at a redirector component or host system. Second, Eggleston '899 is not necessarily a single address system. Accordingly, Mr. Friend's opinions stemming from his conclusion that Eggleston '899 must be a single-address system are misplaced.

b. Eggleston '899 Does Not Disclose Configuring Address Information After Receipt at a Redirector Component or Host System

17. Lazaridis's independent claims 1, 22, 23, 24, 28, 32, and 33 all require configuring address information after receipt at a redirector component or host system. Ex. 2001 at 14:52-58, 16:28-34, 16:59-65, 17:7-17, 17:33-45, 18:13-20, 18:28-39. Eggleston '899 does not explicitly disclose what component populates an email address or where that component is

located. In the mid 1990's it was known that a mobile device, such as the laptop depicted in Eggleston '899 Fig. 1, could populate the "From:" field at the mobile device. In such a system, there is no configuring address information after receipt at a redirector component or host system; in contrast, the address is populated at the mobile device before transmission to any alleged redirector component or host system.

18. Mr. Friend makes a series of arguments directed to whether Eggleston '899 is a single- or dual-address system, which I discuss below. But regardless of whether Eggleston '899 is a single- or dual-address system, it simply does not disclose where or how the address is configured. I find nothing in Eggleston '899 that would indicate their system necessarily must be "configuring address information" after receipt at the virtual session manager ("VSM"), even assuming the VSM could be analogized to a redirector component.

19. Eggleston '899 aims to provide "the same session with the host 115 that the client 105 typically enjoys when connected to the LAN/WAN." Ex. 1001 at 4:44-47. A client operating on a LAN can complete the From: field before transmission of a message. Accordingly, it would be consistent with Eggleston '899 to continue to populate the From: field at a mobile client even when connected through the VSM so the client can use the same session with host 115.

20. Because Eggleston '899 is silent regarding where address information is configured and it was known that address information could be provided at the mobile client, I conclude that Eggleston '899 does not inherently require "configuring address information of the received message" after receipt at a redirector component or host system, as required by Lazaridis's independent claims.

c. Eggleston '899 Is Not Necessarily a Single Address System

21. Mr. Friend argues that Eggleston '899 is a single-address system by stating that if Eggleston '899 were a two-address system, more details would have been disclosed. Ex. 1004 at 9-10. He states: "In fact, Eggleston never mentions using anything other than the single, first address. If a second address were used, it would be a very important part of how Eggleston works and would have to be described in Eggleston -- but it is not. There are a number of important architectural differences between a one-address system and a two-address system. In particular, a two-address system would include several additional elements in the system that would not be present in a one-address system." Ex. 1004 at 10.

22. I agree with Mr. Friend that both single- and dual-address systems existed. This alone indicates to me that Eggleston '899 does not inherently anticipate Lazaridis's claims because Mr. Friend acknowledges dual-address systems. Given the lack of explicit disclosure in Eggleston '899 of either a single- or dual-addresses, I cannot conclude that Eggleston '899 necessarily is a single address system.

23. Mr. Friend also asserts: "Much of the point of Eggleston is to offer a remote client the same experience that he or she would get if he or she were on the LAN, but use the VSM architecture to make it more efficient over the wireless network. . . . This LAN-like experience must involve only a first address because there is no second address involved anywhere in the normal LAN connection to a mail server." Ex. 1004 at 9.

24. I disagree with Mr. Friend's conclusion that the "LAN-like" experience must involve only a first address. In Eggleston '899, the virtual session manager "authenticates and otherwise qualifies the client, including sending a logon/registration message to the host for its

authentication of the client." Ex. 1001 at 6:32-37. Although this authentication and logon process may identify a user, that does not necessarily lead to the conclusion that the user has only a single email address. There is no necessary limit on the number of mailboxes a single user can be assigned permission to access, and, therefore, no limit on the number of email addresses for a user.

25. For example, a user may have one email address for personal use and another for business use. A normal LAN connection to a mail server could provide a user with access to multiple email accounts and addresses from which messages can be delivered. Allowing the user to access these multiple email accounts and addresses through the VSM would provide a similar experience through the VSM as if a user were connected to the LAN.

26. As another example, RFC 822 allows a user to send email on behalf of another user, which results in the From: field being populated with a first address and the Sender: field being populated with a second, different address. Ex. 2006 at 39. For example, assume a secretary sends an email on behalf of her supervisor through the VSM. The secretary presumably may have access to at least two mailboxes and two addresses: one for her supervisor and one for herself. This illustrates that "sending a logon/registration message to the host for its authentication of the client" may verify a user's credentials, but does not lead to the conclusion that the user only has a single address associated with the host.

27. Eggleston '899 also discloses "the query manager is preferably programmed to send query objects at predetermined intervals for each application being run by each active client." Ex. 1001 at 8:3-5. This passage indicates that a single client may be running multiple applications, and the query manager will poll for new data for each application. Taking email as

an example of an application, Eggleston '899 suggests that a single client could simultaneously be running multiple email applications, and the query manager would check for new messages in each application. One reason a user may run multiple email applications would be to access a different email account with each application. Therefore, Eggleston '899 suggests that a user could have multiple email accounts and addresses, and does not necessarily require only a single address associated with a host system.

28. Mr. Friend also alleges that "marking of the mail in the post office must be with reference to mail associated with the post office mail box, i.e., mail associated with the first address." Ex. 1004 at 9. He cites Eggleston's disclosure that "[o]nce reconstructed, the reply message is forwarded to the target unit(s), as well as to the outbox or sent mail folder of the client's post office box." Ex. 1004 at 9. Again, I disagree with Mr. Friend's conclusion that these citations demonstrate Eggleston '899 necessarily requires a single address system. Placing a copy of a message in an outbox does not mean there is only one outbox or only one address.

29. Because I do not agree with Mr. Friend that Eggleston '899 necessarily requires a single-address system, I do not agree with his conclusion that Eggleston '899 inherently discloses that the first address is "share[d]" between "messages generated at either the mobile data communications device or host system," as required by Lazaridis's claims. I also do not agree that Eggleston '899 inherently discloses "configuring address information" after receipt at a redirector component or host.

30. For these reasons it is my opinion that Eggleston '899 does not teach or suggest configuring address information, as recited in all of Lazaridis independent claims 1, 22, 23, 24,

28, 32, and 33 and therefore required by all of the dependent claims. Accordingly, I conclude that Eggleston '899 does not anticipate any of Lazaridis's claims 1-36.

"continuously redirecting"

31. Mr. Friend has also alleged that Eggleston '899 discloses "continuously redirecting" as required by Lazaridis's claims 1-4, 7-9, 16-23, 32, 34, and 36. I begin with a review of Lazaridis '694, then discuss why Eggleston '899 does not disclose this element, and conclude by addressing Mr. Friend's specific statements.

d. Push Technology as Described by Lazaridis '694

32. The first element that I find missing from Eggleston '899 is "continuously redirecting the message from the host system to the mobile data communication device," as recited by, for example, Lazaridis claim 1. Ex. 2001 at 14:42-44. Lazaridis '694 describes "continuously redirecting" messages in the context of push technology. The background of Lazaridis's patent provides an explanation that contrasts push technology, as claimed in Lazaridis, with other forms of technology referred to as polling, querying, or pulling.

33. Polling- or querying-based systems archive data for retrieval by a user in response to a request. Lazaridis explains that these types of systems require an action by the user to initiate synchronization between data stored in two different locations: "the mobile unit 'pulls' the warehoused information from the host in a batch each time the user desires to replicate information between the two devices." Ex. 2001 at 1:54-58.

34. Lazaridis contrasts querying systems with his invention by explaining, "[i]nstead of warehousing (or storing) the user's data items at the host system and then 'synchronizing' the mobile data communication device to data items stored at the host system when the mobile device requests that such items of information be communicated to it, the present invention

employs a 'push' paradigm that continuously packages and retransmits the user-selected items of information to the mobile data communication device." Ex. 2001 at 1:26-33. Indeed, one "advantage of the present invention is that it provides a system and method for triggering the continuous and real-time redirection of user-selected data items from a host system to a mobile data communication device." Ex. 2001 at 4:50-53. Because prior systems only transfer data in response to a query, "the two systems (host and mobile) only maintain the same data items after a user-initiated command sequence that causes the mobile device to download the data items from the host system." Ex. 2001 at 1:58-61.

35. Although not expressly mentioned in Lazaridis, it was known for mobile devices to register with a server or log in to verify a user. After registration, the user would request to retrieve mail messages (pulling or querying), receive any new messages, and then log off. These systems suffer the drawback noted in Lazaridis's background, which is that the user will not receive new messages waiting at a server until the user has registered and requested the new messages. Ex. 2001 at 1:61-2:4. It is also an inconvenience to the user – the Lazaridis push system avoids the need for a user to register or log in to check for new messages.

36. In addition to convenience and maintaining data synchronization, push technology has cost-saving benefits as well. For example, a user may be charged based on the amount of transmitted data, which is common in packet-based networks. Using push technology reduces costs associated with such a system. The process of logging into a server and sending a request for messages involves the exchange of data packets that add cost over time. Lazaridis avoids these additional costs because no login session or query is needed--messages are pushed to the mobile device. In essence, Lazaridis describes a system in which per-packet costs accrue to the mobile client only in proportion to the number of emails that arrive at the host system and are

subsequently pushed to the client, whereas Eggleston describes a system in which per-packet costs accrue to the mobile client in proportion to the duration during which the mobile client would like to receive email—including potentially long periods during which no emails arrive at the host system.

37. Given this background, Lazaridis aimed to solve the problems with querying-based systems by "continuously pushing user-selected data items . . . stored at a host system to a user's mobile data communication device." Ex. 2001 at 2:23-26.

e. Querying Technology As Described By Eggleston '899

38. Eggleston '899 discloses a querying- or polling-based system. Eggleston '899 aims to reduce the costs of querying and using a session with techniques such as optimizing replies and rate governing. Ex. 1001 at 3:35-4:3. Optimizing replies refers to sending only a portion of a reply message to a server for reconstruction, which is independent of whether a technology is push or pull.

39. Eggleston '899 describes rate governing as a way to monitor the user's incurred costs by tracking time for a circuit-switched connection or tracking the amount of data transmission for packet-based connections. Ex. 1001 at 13:64-14:9. Once a user reaches a predetermined limit, an alert can be sent to the user. Ex. 1001 at 14:23-29. Eggleston '899 also indicates that the current session may be terminated and further sessions may be prevented until additional charges are authorized. Ex. 1001 at 14:30-36.

40. I conclude that Eggleston '899 is directed to polling or querying systems for several reasons. Eggleston '899 expressly states that the communication server "preferably authenticates and otherwise qualifies the client, including sending a logon/registration message

to the host for its authentication of the client." Ex. 1001 at 6:34-36. Once a logon is confirmed and a "virtual session" is established, Eggleston '899 discloses that "a query is preferably generated by query manager requesting unprocessed data for the user, and the VSM forwards the query to the host." Ex. 1001 at 6:58-61. In the example of email, the query requests all unread email messages. Ex. 1001 at 6:61-65. Thus, Eggleston '899 only sends email to a user after the mobile client has registered, the logon process has completed, and a query for new messages has been sent from the query manager to the host.

41. Eggleston '899 therefore discloses that the process of establishing a session and retrieving a user's email is querying-based. A client must be registered with the VSM and a logon to the host must be completed before the VSM will request messages. Only after authentication, logon, and a query will the VSM retrieve any new messages for delivery to a user. Eggleston '899 in fact teaches away from using push technology by stating that "rather than have all new data from the host pushed down to the communication server, most data exchanges are preferably initiated, at some predetermined interval or intervals, by the communications server (e.g., by the query manager)." Ex. 1001 at 7:27-32.

42. Further, Eggleston 899's disclosure of cost control by logging off and ending a session indicates that it is not "continuously redirecting" messages. Eggleston '899 requires a logon, and uses timers to determine how long the virtual session is active. For example, "if no data exchange occurs within a predetermined period of time, say 20 minutes, both the client and VSM would remove the client qualification (i.e., destroy the client object for the communication session)" Ex. 1001 at 7:44-49. The VSM also "forward[s] a logoff message to the host." Ex. 1001 at 7:48-50.

43. Eggleston '899 confirms that once the virtual session has been terminated, "the client will not be notified of outbound data until the client re-registers and is again coupled via the virtual session manager." Ex. 1001 at 7:55-58. This statement further supports that Eggleston '899 only sends messages to a user in response to a request, generated by the query manager, after the mobile client has registered with the VSM and the VSM has logged onto the host system. Messages are not continuously redirected or pushed as recited in Lazaridis's claims, and Eggleston '899 acknowledges that a user will not receive any messages absent an active connection to the VSM and login to the post office.

44. Eggleston '899 seeks to reduce costs by timing out a session once a threshold of usage is reached. After reaching the threshold, Eggleston '899 "terminat[es] the current session and prevent[s] further sessions until additional use limit time/charge is authorized." Eggleston Ex. 1001 at 14:34-36. Eggleston '899 therefore ends the session and stops transmitting data to a user, meaning the user will not receive any new email messages. I do not consider a system that intentionally terminates transmission of messages in this way to be one that "continuously" redirects messages.

45. Accordingly, I conclude that Eggleston '899 does not teach or suggest "continuously redirecting" messages as recited by Lazaridis independent claim 1. More appropriately, Eggleston '899 discloses the type of register-and-login-based querying system that Lazaridis overcame.

f. Mr. Friend's Analysis Regarding "Continuously Redirecting"

46. In my opinion, Eggleston '899 discloses the very type of prior system that Lazaridis overcame by claiming and describing "continuously redirecting" or push technology. I address now the specific allegations by Mr. Friend.

47. I have reviewed Mr. Friend's opinion that Eggleston '899 discloses "continuously redirecting" and cannot agree. Mr. Friend states "as long as the virtual session remains active after the redirection trigger, messages are continuously redirected from the host system to the mobile device." Ex. 1004 at 7. Mr. Friend also states "Eggleston also shows that, when the Post Office receives new email for the mobile device, that email is sent on to the mobile client by the VSM when it arrives. This means that redirection is triggered when the new email arrives – and this is done anytime new email arrives as long as the virtual session is established. Eggleston at Fig. 3. This further demonstrates the continuous nature of the redirection disclosed in Eggleston." Ex. 1004 at 8.

48. Without more analysis, it is difficult to understand the basis for Mr. Friend's opinion. It appears he believes Eggleston '899 shows "continuously redirecting" by forwarding messages while a virtual session is established. I disagree.

49. When a virtual session is established, Eggleston '899 describes a querying system. Query manager 231, illustrated in Fig. 2, is responsible for "sending messages to a post office to query for unprocessed messages and forward[] receive messages." Ex. 1001 at 5:53-56. The VSM queries for new messages only after registering a user and establishing a virtual session. Ex. 1001 at 6:58-61. After an initial request to the post office for new messages, the "query manager is preferably programmed to send query objects at predetermined intervals for each application being run by each active client." Ex. 1001 at 8:2-7. Query manager 231 therefore continues to query for new messages on behalf of a user at "predetermined intervals" or periodically once a session has been established; Eggleston '899 does not continuously redirect or push messages.

50. I have also discussed how Eggleston '899 does not send messages to a user before a virtual session has been established or after the virtual session has ended. I would expect that users of Eggleston '899 would avoid establishing a virtual session specifically to limit the costs associated with Eggleston's system. Indeed, Eggleston '899 cuts off communication to save costs for the user and acknowledges that no data will be sent. Ex. 1001 at 7:55-58; 14:30-36. Therefore, absent a virtual session, there are no requests for new messages and no emails are sent to a user. Logging off and not sending messages to a user is the opposite of "continuously redirecting" messages, as required by Lazaridis's claims.

51. I have discussed above how the process of retrieving email for a user through the VSM is querying- or polling-based. A mobile client is registered and authenticated, followed by the VSM's logging into the post office, and then the VSM's query manager requests any new messages. Ex. 1001 at 6:23-65. The type of system described by Eggleston '899 simply has no "continuous redirection" element during the process of establishing a virtual session and querying a post office for new messages, nor during periods when no virtual session is established.

52. Further, there is a negative tradeoff in Eggleston '899 that is not present in Lazaridis. Eggleston '899 terminates a virtual session once a user has been logged in long enough to raise costs to a threshold. Ex. 1001 at 14:33-36. Eggleston '899 terminates the session, and prevents further sessions, to limit charges to a user. Ex. 1001 at 14:29-36. Once the session has been ended, no emails are sent to a user. Ex. 1001 at 7:55-58. The tradeoff is thus that the user must choose either to incur costs for maintaining a session or to endure periods during which he cannot receive email (i.e., he can only receive email upon re-establishing a session and querying for new messages). This type of tradeoff was eliminated by Lazaridis,

which provides a system where a user can receive new messages "continuously" without the need for queries or a virtual session. Ex. 2001 at 1:67-2:17. In this sense, Lazaridis provides a more cost-efficient system than that disclosed by Eggleston '899. Ex. 2001 at 2:10-17.

53. In addition, the process of maintaining a virtual session as disclosed in Eggleston '899 adds costs to the system. A user may establish a virtual session to request new messages, but if no new messages are available, the user experiences costs both in the form of network charges for data packets exchanged to register with the VSM and in the form of battery life consumed to send the data packets. Furthermore, maintaining active sessions places burdens on the virtual session manager and makes Eggleston '899 less scalable to a large number of users. The VSM of Eggleston '899 must query a post office for new messages on behalf of users who have active sessions, a process that consumes the VSM's resources. Lazaridis solved these problems by "continuously redirecting" messages without the need for a virtual session manager, in contrast to Eggleston '899.

54. I therefore find that Eggleston '899 does not teach or suggest "continuously redirecting," as recited by Lazaridis's claims 1-23, 32, and 34-36. I also conclude that it would not have been obvious to modify Eggleston '899 with any of the other prior art cited by Mr. Friend, or any other prior art that I am aware of, to arrive at a system that "continuously redirect[s]" messages.

V. Eggleston '899 in view of Shirakihara Does Not Render Any of Lazaridis's Claims Obvious

55. I understand that a patent may not be obtained if the differences between the subject matter for which a patent is sought and the prior art are such that the subject matter as a

whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

56. I understand that a common-sense approach should be used when examining the claimed invention and its functions to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.

57. I understand that the effects of demands known to the design community or present in the marketplace and the background knowledge possessed by a person having ordinary skill in the art should be considered to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue.

58. I understand that the inferences and creative steps that a person of ordinary skill in the art would employ should be considered in determining whether a claimed invention is obvious.

59. Mr. Friend alleges that Eggleston '899 in combination with Japanese patent publication No. JP8070300 to Shirakihara (hereinafter, "Shirakihara") renders obvious Lazaridis's claims 1-5, 7-9, 16-25, 28-30, 32-34, and 36. I disagree for the reasons below.

60. Shirakihara discloses that "[a]n object of the present invention is to share files processed by each mobile computer among computers on a temporarily formed network." Ex. 1003 at 1. To accomplish this objective, "[a]n address conversion device that is capable of storing a fixed address on network, acquiring/storing an address for a mobile computer connected to the network, and address conversion using said fixed address and said mobile

computer address is provided in correspondence to each connector on network to which mobile computer is connected. Message transmission among mobile computers is achieved by said address conversion using an assigned source address and an assigned destination address." Ex. 1003 at 1.

61. Shirakihara is directed to network-level addressing within a temporary network. Ex. 1003 at 1, ¶ 0023, ¶ 0025. Shirakihara does not teach or suggest an email system or email addresses. Mr. Friend's leap to combine Eggleston '899 with Shirakihara to teach address transparency is not convincing because network-level addressing is very different from email addressing.

62. There are many layers involved in network communication, each with its own addressing system. While many users may think of the email address typed in the "To:" field as the only destination address, the actual delivery of a message is more complicated. An analogy can be made to normal U.S. postal mail to illustrate the multiple layers of addressing used during email delivery.

63. A letter delivered through postal mail typically has two addresses on it: the source address of the person who sent the letter, and the destination address of the person to whom the letter should be delivered. However, delivering the message involves other addresses, none of which are seen by the recipient. For example, the message may be taken to a local postal center for sorting, delivered to a regional mail hub, delivered to a postal center local to the recipient, and finally placed in the recipient's mailbox. Each stop along the delivery process has an address associated with it, but the recipient is unaware of those addresses. These addresses may, for example, be affixed to the exterior of mail sacks that carry many articles of mail

between local postal centers and mail hubs. The addresses on the envelope itself persist within the mail sack, but the letter's final recipient does not see the sack that carried it along the way, nor the intermediate address affixed to the exterior of that sack.

64. An email address or application-level address is akin to the addresses on the letter envelope. Both the sender and recipient see these addresses. However, delivery of the email involves routing the messages through intermediary devices based on lower-level addressing schemes including network addresses. Unlike email addresses, the sender and recipient are typically unaware of these network addresses.

65. Shirakihara's system of changing network addresses, therefore, does not relate to email addresses, nor does it relate to the concept of address transparency from a recipient's viewpoint. Rewriting network addresses does not affect where a user would think an email originated based on the email address. Normal email delivery involves changing network addresses associated with each hop along the delivery path through the Internet, but that in no way provides or relates to address transparency.

66. Mr. Friend acknowledges that network level addresses and email addresses are "very different" things. Ex. 2080 at 205:14-206:3. I agree, and I conclude that it would not have been obvious to apply the very different concept of rewriting a network address, as disclosed by Shirakihara, with the email system of Eggleston '899 to arrive at address transparency.

67. Additionally, Mr. Friend alleges that "Shirakihara discloses that messages generated at either the address conversion device or the mobile computer appear to share the address conversion device's single fixed address." Ex. 1004 at 79. However, message content is

not generated at Shirakihara's address conversion device. Mr. Friend confirmed this during his deposition:

> Q. Do you have any understanding of Shirakihara . . . that teaches that content would be generated or message would be generated at the address-conversion device?
>
> A. I'm not aware of any place in Shirakihara where it talks about generating content.

68. Ex. 2080 at 237:3-11. Mr. Friend therefore backed away from his previous assertion that Shirakihara discloses generating messages at the address conversion device, leading me to conclude that even Mr. Friend acknowledges that Shirakihara does not render Lazaridis's claims obvious.

69. Shirakihara's address conversion device therefore does not constitute a "host system" as in Lazaridis's claims for the additional reason that it cannot generate message content. This contrasts with Lazaridis's claim 28, for example, which requires that "*messages generated* at either the mobile data communications device *or the host system* share the message sender's first address." Ex. 2001 at 17:42-45.

70. Finally, I discussed above how Mr. Friend argues that Eggleston '899 necessarily requires only a single-email-address system and teaches away from a two-email-address system. Ex. 1004 at 9-10. Specifically, Mr. Friend alleges: "With the ability to have that connection to the first address server, there would be no reason to use a two-address system" in Eggleston '899. Ex. 1004 at 10. I have already explained why I do not agree that Eggleston '899 necessarily requires a single-address system. But regardless, Mr. Friend indicates there would be "no reason" to use two email addresses in Eggleston '899 (Ex. 1004 at 10), let alone modify Eggleston '899 with two network addresses as disclosed by Shirakihara. I therefore disagree that

it would have been obvious to somehow combine Eggleston '899 with Shirakihara to construct a system that "configures address information," as required by Lazaridis's claims 1-36.

VI. Eggleston '899, Shirakihara, and the Secondary References cited by Eggleston Do Not Render Any of Lazaridis's Claims 1-36 Obvious

71. I understand that dependent claims include the limitations of the independent claims from which they depend. I have reviewed the various secondary references that Eggleston cites as relating to Lazaridis's dependent claims. However, none of the cited secondary references teach or suggest "configuring address information" or "continuously redirecting," as discussed above. I therefore conclude that Lazaridis's claims 1-36 are not anticipated or obvious in view of the prior art.

VII. RIM's Prior Work Discloses As Much As Eggleston '899

72. I have been advised that an interference is a proceeding to determine the party that first invented subject matter defined by an interference "count." I understand that the count in the present interference between RIM's '694 patent and Motorola's Eggleston application is defined by the invention recited in claim 60 of the Eggleston application:

> 60. A method for forwarding messages generated at a mobile client by a message sender destined for a message recipient, comprising the steps of:
>
> receiving a message, generated at the mobile client by the message sender destined for the message recipient, at a forwarding component associated with a host system, wherein messages generated at the host system by the message sender use a first address;
>
> configuring the received message such that the received message appears to the message recipient as if the received message originated at the sender's first address, wherein messages generated at either the mobile client or host system appear to originate at the message sender's first address; and
>
> forwarding the configured received message to the message recipient.

73. Counsel for RIM asked for my opinion regarding whether RIM's computer system called "RIMGate" satisfied every element of the interference count (claim 60 above). In reaching my opinion, I considered the sworn declarations of Gary Mousseau and Herb Little, the exhibits attached to their declarations, and any additional exhibits referenced in this declaration. Based on the evidence that I considered, it is my opinion that RIMGate satisfied every element of the interference count.

74. As early as February 16, 1993, Mihal Lazaridis and Gary Mousseau conceived of a computer system, called RIMGate, that was designed to extend X.25 services, such as AT&T EasyLink services, to mobile users in a wireless Mobitex network. Ex. 2084, ¶¶ 7-9. By April 2, 1993, Gary Mousseau and a team of AT&T engineers had implemented a working RIMGate system that enabled mobile users in RAM Mobile Data's Mobitex network to send and receive e-mail messages using their AT&T Mail accounts located on a centralized AT&T server. Ex. 2084, ¶¶ 14, 25. The above-noted RIMGate / AT&T EasyLink system was set up and tested at AT&T's offices in the United States. Ex. 2084, ¶ 14; Ex. 2085, ¶¶ 13-15. As explained below, the RIMGate / AT&T EasyLink system implemented at AT&T's offices as early as April 2, 1993 satisfied every element of the count recited in claim 60 of the Eggleston application. See Ex. 2084, ¶¶ 22-38; Ex. 2085, ¶ 16.

75. It is my opinion that the RIMGate / AT&T EasyLink system performed a "method for forwarding messages generated at a mobile client by a message sender destined for a message recipient" as recited in the preamble of claim 60 of the Eggleston application.

76. In the RIMGate / AT&T EasyLink system, a mobile user (message sender) at a portable computer (mobile client) in the Mobitex network generated AT&T Mail e-mail

messages (messages) destined for one or more intended recipients (message recipient). Ex. 2084, ¶¶ 32-37. The AT&T Mail e-mail messages were sent from the mobile user's portable computer to RIMGate which, in turn, forwarded the messages to the AT&T server. Ex. 2084, ¶¶ 22, 37. The AT&T server processed the received e-mail messages and forwarded the messages to their addressed recipients. Ex. 2084, ¶¶ 36-37. In this manner, the RIMGate / AT&T EasyLink system forwarded e-mail messages "generated at a mobile client by a message sender destined for a message recipient" as claimed.

77. It is also my opinion that the RIMGate / AT&T EasyLink system performed a step of "receiving a message, generated at the mobile client by the message sender destined for the message recipient, at a forwarding component associated with a host system" as recited in claim 60 of the Eggleston application.

78. At least as early as April 2, 1993, Gary Mousseau and the team of AT&T engineers successfully sent and received messages using the RIMGate / AT&T EasyLink system. Ex. 2084, ¶¶ 14, 34; Ex. 2085, ¶¶ 14-15. Specifically, RIMGate received an AT&T Mail e-mail message generated by a mobile user in the Mobitex network and *forwarded* that message to the AT&T server. Ex. 2084, ¶¶ 22, 37. The AT&T server processed the received e-mail message, e.g., inserting the message sender's AT&T e-mail address, and then *forwarded* the message to its addressed recipient(s). Ex. 2084, ¶¶ 35-37. Accordingly, in the context of the RIMGate / AT&T EasyLink system, the claimed "forwarding component associated with a host system" corresponds to at least one of RIMGate and the AT&T server, each of which received and forwarded an AT&T Mail e-mail message generated by a mobile user in the Mobitex network.

79. I understand that the Board of Patent Appeals and Interferences (BPAI) of the U.S. Patent and Trademark Office has interpreted the meaning of a "forwarding component associated with a host system" as claimed in the Eggleston application. The Board found that the Eggleston application discloses both a communication server and a post office host server, each of which is allegedly configured to receive and forward e-mail messages generated by a mobile client. Ex. 2017 at 7. After noting that each of the communication server and host server can be configured to receive and forward e-mail messages generated by a mobile client, the Board held that the Eggleston application specification "makes it clear to the artisan that at least one of the communication server [] and the post office host server [], is a 'forwarding component associated with a host system,' as claimed." Ex. 2017 at 7.

80. To the extent that the Board considered at least one of the communication server and host server in the Eggleston application (and thus also in Eggleston '899 having the same specification in relevant part) to be the claimed "forwarding component associated with a host system," by the same logic at least one of RIMGate and the AT&T host server also must correspond to a "forwarding component associated with a host system," as recited in claim 60 of the Eggleston application. Like the communication server and host server (Figure 1 below) disclosed in the Eggleston specification, RIMGate and the AT&T host server (Figure 2 below) are similarly connected and are also each configured to receive and forward e-mail messages generated by a mobile client located in a wireless network.

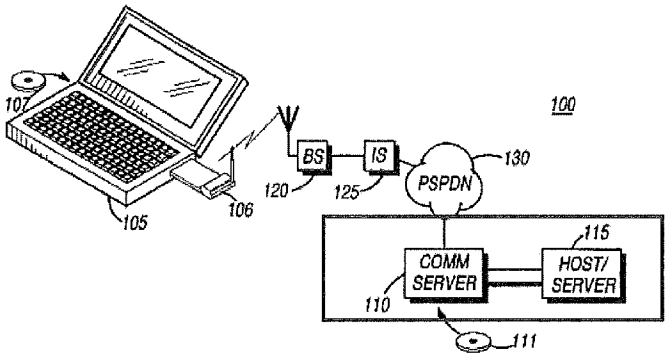

FIG.1

Figure 1: Configuration of the mobile user, communication server, and host server disclosed in the Eggleston specification. Ex. 1001, Figure 1 (annotated box added).

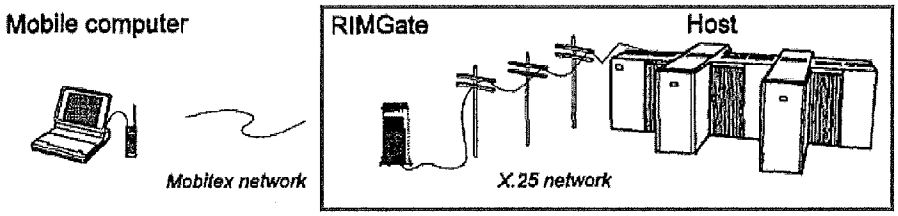

Figure 2: Configuration of the mobile computer, RIMGate, and host server in the RIMGate system. Ex. 2061 at 57 (portion of figure) (annotated box added).

81. It is my opinion that the RIMGate / AT&T EasyLink system also satisfied the claim limitation of "wherein messages generated at the host system by the message sender use a first address" as recited in claim 60 of the Eggleston application.

82. In the RIMGate / AT&T EasyLink system, every mobile user subscribed to the AT&T Mail service was assigned an e-mail address associated with the user's electronic mailbox on the AT&T host server. Ex. 2084, ¶ 25. For example, the AT&T Mail Access PLUS for Windows User's Guide disclosed that "an AT&T Mail subscriber with a user name of 'jdoe' will be addressed as jdoe@attmail.com" to other internet users of the AT&T Mail service. Ex. 2063

at 3-14. The AT&T Mail service at the AT&T server inserted a sender's e-mail address into the FROM: field of every e-mail message generated by AT&T Mail subscribers. Ex. 2084, ¶ 35-36. Thus, messages generated by a message sender (e.g., jdoe) in the RIMGate / AT&T EasyLink system used a first address (e.g., jdoe@attmail.com) at the AT&T host server, as required by the claim 60.

83. Further, mobile users in the RIMGate / AT&T EasyLink system could generate e-mail messages either on their portable computers or on the AT&T host server. Ex. 2084, ¶¶ 32-33. For example, I understand that while testing and monitoring the interoperability of RIMGate and AT&T EasyLink services from April 1993 to October 1993, Gary Mousseau generated e-mail messages on at least one portable computer and also generated e-mail messages using software that accessed the AT&T Mail service on the AT&T server. Ex. 2084, ¶ 34. For at least those e-mail messages that were generated on the AT&T server (Ex. 2084, ¶¶ 32-34), where the AT&T Mail service inserted the message senders' e-mail addresses into the messages' FROM: fields (Ex. 2084, ¶¶ 35-36), it is my opinion that the messages satisfied the limitation "wherein messages generated at the host system by the message sender use a first address" as recited in claim 60 of the Eggleston application.

84. It is my understanding that Eggleston may allege that the "messages generated at the host system by the message sender" recited in the interference count correspond to the following disclosure in column 3, lines 36-47 of Eggleston '899: "on receiving the optimized reply, the communication server . . . reconstructs the full reply . . . and forwards the full reply to the addressee." Eggleston Motion No. 1, Appendix C, at C-45 (proposing a mapping of Eggleston '899 to the claim phrase "messages generated at the host system by the sender"). In the event that Eggleston alleges that the claimed "messages generated at the host system by the

message sender" correspond to receiving an optimized reply message as a stream of packets at a communication server, reassembling the packets, and forwarding the reply at the communication server, as taught in Eggleston (Ex. 1001, col. 3, ll. 36-47 and col. 5, ll. 13-17), then it is my opinion that the RIMGate system likewise comprised "messages generated at the host system by the message sender," as claimed.

85. Like the communication server's processing of an optimized reply message in Eggleston, the RIMGate / AT&T EasyLink system also received an e-mail message as a stream of packets, reassembled the packets, and then forwarded the e-mail message. Specifically, a mobile user sent the e-mail message as a sequence of Mobitex packets (MPAKs) to RIMGate. Ex. 2084, ¶¶ 23, 37. RIMGate received the MPAKs and reassembled them into transport level messages containing the e-mail message. Ex. 2084, ¶ 37. RIMGate then forwarded the e-mail message as a sequence of X.25 packets to the AT&T server. Ex. 2084, ¶ 37. The AT&T server received the sequence of X.25 packets and reassembled them back into the e-mail message. Ex. 2084, ¶ 37. Thereafter, the AT&T server filled in the user's e-mail address into the FROM: field of the message (Ex. 2084, ¶¶ 35-36) and sent the e-mail message to its addressed recipients (Ex. 2084, ¶¶ 36-37).

86. It is also my opinion that the RIMGate / AT&T EasyLink system performed a step of "configuring the received message such that the received message appears to the message recipient as if the received message originated at the sender's first address, wherein messages generated at either the mobile client or host system appear to originate at the message sender's first address" as recited in claim 60 of the Eggleston application.

87. In the RIMGate / AT&T EasyLink system, a mobile user did not include his or her e-mail address in the FROM: field of a new e-mail message, regardless of whether the user generated the message on a portable computer or on the AT&T server. Ex. 2084, ¶ 35. Rather, the AT&T service itself populated the FROM: field of a new e-mail message with the sender's e-mail address. Ex. 2084, ¶ 36. Because the AT&T Mail service on the AT&T server inserted the e-mail address of the sender into the FROM: field, the message recipient(s) could not distinguish whether the sender generated the e-mail message on a portable computer or on the AT&T server. Ex. 2084, ¶ 38. For this reason, it is my opinion that the AT&T Mail service on the AT&T server "configur[ed] the received message such that the received message appears to the message recipient as if the received message originated at the sender's first address, wherein messages generated at either the mobile client or host system appear to originate at the message sender's first address" as recited in claim 60 of the Eggleston application.

88. I understand that the Board has identified a so-called "transparency feature" in the claims of the Eggleston application, such that message recipients are unaware whether messages originated at a first address associated with the host system rather than at the host system itself. Ex. 2017 at 8-9. Thus, in the context of claim 60 of the Eggleston application, the Board's identified "transparency feature" corresponds to the step of "configuring the received message such that the received message appears to the message recipient as if the received message originated at the sender's first address, wherein messages generated at either the mobile client or host system appear to originate at the message sender's first address."

89. The Board found that the claimed "transparency feature" was satisfied when "the user does not e-mail directly from his mobile unit, i.e., the mobile client does not have an e-mail address or e-mail functionality, but that *the host server provides the e-mail address and forwards*

e-mail to recipients who are unaware of any address from the mobile client." Ex. 2017 at 9 (emphasis added). The Board's characterization of the so-called "transparency feature" corresponds precisely to how the RIMGate / AT&T EasyLink system worked. That is, the mobile user did not insert his or her e-mail address into a new e-mail message. Ex. 2084, ¶ 35. Instead, the AT&T host server provided the sender's e-mail address into the FROM: field and forwarded the e-mail to recipients who were unaware of any address from the mobile client. Ex. 2084, ¶¶ 36-38. Thus, consistent with the Board's reasoning, it is my opinion that the RIMGate / AT&T EasyLink system satisfied the transparency feature set forth in the "configuring" step recited in claim 60 of the Eggleston application.

90. It is my opinion that the RIMGate / AT&T EasyLink system performed a step of "forwarding the configured received message to the message recipient" as recited in claim 60 of the Eggleston application. After the AT&T server populated the FROM: field of a received e-mail message, thereby configuring the received message, the AT&T server sent the configured message to each of the message's addressed recipients. Ex. 2084, ¶¶ 36-37. In this way, the AT&T server "forward[ed] the configured received message to the message recipient" as claimed.

VIII. Eggleston's New Claim - "mobile client" versus "mobile email client"

91. I understand that Eggleston has proposed claim 115, as follows:

> A method for forwarding messages generated at a mobile email client by a message sender destined for a message recipient, comprising the steps of:
>
> > receiving a message, generated at the mobile email client by the message sender destined for the message recipient, at a forwarding component associated with a host system, wherein messages generated at the host system by the message sender use a first address;
> >
> > configuring the received message such that the received message appears to the message recipient as if the received message originated at the sender's first

address, wherein messages generated at either the mobile email client or host system appear to originate at the message sender's first address; and

forwarding the configured received message to the message recipient.

92. The only difference between claim 60 and proposed claim 115 is the limitation "mobile client" in the former and "mobile email client" in the latter.

93. I understand that Eggleston argues that claim 60 is precisely the same scope as proposed claim 115.

94. I have reviewed the Substitute Second Declaration of John Friend (Ex. 1031) and disagree that the difference between claim 60 and proposed new claim 115 would have had no effect on the claim's substantive meaning to a person of ordinary skill in the relevant field in the December 1995 timeframe.

95. In the December 1995 timeframe, the ordinary meaning of the term "mobile client" in the field of electronic messaging systems was broadly understood to refer to portable hardware and its software or its software alone that allowed a user to use applications.

96. The "mobile client" of claim 60 is not limited to a device that uses any particular software application or any particular software application. As the Eggleston application states, the system described in the Eggleston specification "can also be used with almost any application program or groups of programs (e.g., transferring database, wordprocessing, graphics, voice etc. files, executing programs and control messages, etc.), not just email or groupware." Ex. 2002 [Eggleston application] ¶ 59. The Eggleston application also explains that a "message" is "any appropriate data unit (whether frame, datastream, packet, or other format), including objects,

datagrams, etc., for containing information being communicated." *Id.* ¶ 27. Thus, nothing in claim 60 limits the claim to e-mail applications or e-mail messages.

97. The term "mobile email client" does not appear anywhere in the Eggleston specification or the prosecution history for the Eggleston specification. In the December 1995 timeframe, however, one of skill in the art would likely have understood that the term "mobile email client" means portable hardware and its software or its software alone that allowed a user to send and receive email.

98. It is my opinion that a "mobile email client" of proposed claim 115 is substantially different than a "mobile client" of claim 60. A "mobile client" differs from a "mobile email client" because a "mobile client" of claim 60 is not limited to e-mail, like a "mobile email client" of claim 115. As explained above, the "mobile client" of claim 60 can be a combination of hardware and software or software that allows a user to transfer database, wordprocessing, graphics, voice etc. files, and execute programs and control messages. Thus, the "mobile client" of claim 60 is materially different than the "mobile email client" of proposed claim 115, which requires a user to send and receive email.

99. I understand that Mr. Friend has testified that a "mobile client" is a "[a] piece of client software on a wireless device." Ex. 2080 [Friend Transcript] at 65:8-15, and has defined a "mobile email client" as "a mobile client that can perform e-mail functions." *Id.* at 84:14-22. I also understand that he testified that a "mobile email client" must be a device with which a user can read and send email.

100. In my opinion, even under Mr. Friend's definition of a "mobile client" and "mobile email client," the "mobile email client" is materially different than a "mobile client" for

the same reasons expressed above. That is, because the "mobile client" is not necessarily limited to e-mail applications, it is not of precisely the same scope as a "mobile email client." I therefore disagree that a person of ordinary skill in the art would consider a "mobile email client" to be redundant to a "mobile client."

IX. sendmail in view of Simon Renders Obvious Eggleston's New Claim 115

101. I have reviewed the reference *sendmail* by Bryan Costales, O'Reilly & Assocs., Inc., Nov. 1993 ("*sendmail*") and the reference *Simon Says "Here's How!"*, User Manual, 1st ed., Feb. 1994 ("*Simon*").

102. I understand that Lazaridis's expert, Dr. Gary Tjaden, has opined that *sendmail* in view of *Simon* renders claim 60 obvious. I have reviewed his opinion and agree with his analysis. Ex. 2005 [Tjaden Decl.] ¶¶ 74-91, Appendix 3. I understand that Mr. Friend disagrees with Dr. Tjaden and has opined that a person of ordinary skill in the relevant field in the December 1995 timeframe would not have had a reason to combine *sendmail* and *Simon*. I disagree with Mr. Friend's opinion.

103. I understand that a court can look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art to determine whether there was an apparent reason to combine known elements in the fashion claimed by the patent at issue.

104. I understand that any need or problem known in the field and addressed by the patent can provide a reason for combining the elements in the manner claimed.

105. *sendmail* teaches an electronic mail system in which all outgoing messages from clients are sent to a hub, and the hub forwards the mail to its ultimate destination. Ex. 2025 [*sendmail*] at 50.

106. *sendmail* also teaches that all outgoing messages are modified so that they appear to have come from the hub. *sendmail* therefore makes all messages appear to have come from the hub by rewriting the sender's address so that the mail messages always appear to have originated at the hub machine. For example, the sender's address "user@client" becomes "user@hub." Ex. 2025 [*sendmail*] at 50, 115.

107. *Simon* teaches a handheld, wireless mobile device that can send and receive e-mail messages by connecting to a Lotus 'cc:Mail' post office. Ex. 2026 [*Simon*] at 1. Because the *Simon* mobile device can read and send e-mail, *Simon* teaches a "mobile email client" of proposed claim 115.

108. Mr. Friend states that a person of ordinary skill in the art in the December 1995 timeframe who was implementing a product like *Simon* would not have had any reason to know or any particular reason to know anything about *sendmail*. I disagree with Mr. Friend and believe that his view of the knowledge of a person of skill in the art is too narrow. In fact, in the December 1995 timeframe, I was personally familiar with *sendmail*. I configured *sendmail* on many computers in the December 1995 timeframe and earlier.

109. I also disagree with Mr. Friend that *sendmail* and *Simon* have nothing in common and that a person of ordinary skill in the art in the December 1995 timeframe would not have a reason to combine the two references because "it would not have made sense." Ex. 1031 [Second Friend Decl.] ¶ 7. Both *sendmail* and *Simon* relate to the field of electronic messaging

systems. *sendmail* teaches a system that includes each of the limitations of the claim except for a mobile e-mail client. *Simon* teaches an electronic messaging system that utilizes a mobile e-mail client. In the December 1995 timeframe, there was a known design need and strong commercial motivation to develop communications systems for wireless access to e-mail using mobile devices. Thus, extending the *sendmail* system to the mobile environment taught by *Simon* was an obvious solution to the problem that was well within the skill of a person of ordinary skill in the art.

110. To build a system combining *sendmail* and *Simon*, a person of ordinary skill in the art in the December 1995 timeframe would simply use *Simon* to transfer messages from the mobile device to the cc:mail server, which could then be linked to the *sendmail* mail transfer agent, which a person of ordinary skill in the art could configure according to the teachings of *sendmail* to satisfy the limitations of proposed claim 115. One example of a product linking cc:mail to *sendmail* was Lotus "cc:Mail Link to SMTP 2.0", which connected cc:Mail users with "Unix-based messaging systems" (e.g., *sendmail*). *See* Ex. 2087. Contrary to Mr. Friend's suggestion, combining Simon, cc:Mail, and *sendmail* would not have required any knowledge of proprietary workings of cc:Mail given the public release cc:Mail Link to SMTP 2.0. Indeed, Mr. Friend has already acknowledged that "he was aware at the time that sendmail understood SMTP." Ex. 2080 at 172:14-15. Thus, in my opinion, a person of ordinary skill in the art in the December 1995 timeframe would have been motivated to combine *sendmail* and *Simon* according to claim 115.

111. Mr. Friend also opines that *sendmail* teaches away from the "transparency feature," which I understand is Eggleston's shorthand way of referring to the step of "configuring the received message such that the received message appears to the message

recipient as if the received message originated at the sender's first address, wherein messages generated at either the mobile email client or host system appear to originate at the message sender's first address." Mr. Friend asserts that *sendmail* teaches away from the "transparency feature" because *sendmail* discloses that "one Received: line appears for each machine that handled the message on its way from the sender to the recipient. Each machine that handles a mail message adds one of these lines." He asserts that this is the opposite of transparency because a user can see the exact route that an email has taken before arriving at its ultimate destination. Mr. Friend then cites RFC 822's description of the "Received" line header and states that, because *sendmail* follows RFC 822 and "makes a record of each machine that mail has passed through," that is the "opposite of transaprency." Ex. 1031 [Second Friend Decl.] ¶ 8. As such, Mr. Friend asserts that *sendmail* teaches away from transparency, and argues that because there was no reason to combine *sendmail*, which fails to disclose a "mobile email client," and *Simon*, which fails to disclose the transparency feature, proposed new claim 115 is patentable over these references.

112. I disagree with Mr. Friend's analysis that *sendmail* teaches away from the "configuring" step of proposed new claim 115. *sendmail* teaches that to route all mail through the "host" or hub, "[a]ll outgoing mail is modified so that it appears to have come from the hub." Ex. 2025 [*sendmail*] at 50. *sendmail* does so by "rewrit[ing] the sender's address in such a way that the mail message always appears to have originated at the hub machine." *Id.* at 115. In my opinion, this is an explicit teaching of the "configuring" step of the claim.

113. The "Received" line in the header does not necessarily say anything about whether a message is configured such that it "appears to the message recipient as if the received message originated at the sender's first address, wherein messages generated at either the mobile

email client or host system appear to originate at the message sender's first address." According to RFC 822, the "Received" line is added by each transport service that relays the message. Ex. 2006 [RFC 822] at 20. Nothing in the "Received" line necessarily indicates where a user is located. In fact, it is common to have multiple mail servers for the same domain, and an email can go through several mail servers regardless of the user's location.

114. Mr. Friend provides a hypothetical to try to support his opinion. He states that if a user were on a trip to Boston and sent an email from the Boston office's mail servers, the fact that the email was sent from Boston would have been indicated in the "Received" lines of the email. Ex. 1031 [Second Friend Decl.] ¶ 8. But in the system combining *sendmail* with *Simon* and cc:mail, the message would first be sent to the cc:mail server associated with the Simon device and would then go to the sendmail server where the address would be rewritten. Thus, regardless of the user's physical location, the first server listed in the "Received" line would be the cc:mail server. Accordingly, the message recipient would be unaware of the user's location from the "Received" line in the header. As such, I believe Mr. Friend's Boston hypothetical is incorrect and, in particular, not true for the combination of *Simon* and *sendmail* because even if the user were in Boston, the mobile email client would connect back to the cc:mail server, and not a Boston server.

115. Furthermore, the system described in the Eggleston specification can include SMTP systems. As such, messages sent by the Eggleston system would include the "Received:" line header information, as described in RFC 822. Messages sent using the Eggleston system would include information about each SMTP server that handled the message. Thus, if the presence of SMTP servers' identity information in "Received" lines does not teach the "configuring" step of the claim, Eggleston's application does not teach the feature, either.

116. It is therefore my opinion that one of ordinary skill in the art would have been motivated to combine the *sendmail* and *Simon* references in the manner claimed by proposed new claim 115.

IX. Documents Considered Relating to This Declaration

117. In addition to the involved Lazaridis patent, Eggleston application, and their associated file histories, I have considered:

a. U.S. Patent No. 5,764,899 to Eggleston (hereinafter referred to as "Eggleston "Eggleston '899," Exhibit 1001)

b. U.S. Patent No. 6,052,563 to Macko (Exhibit 1006)

c. U.S. Patent No. 5,819,284 to Farber (Exhibit 1007)

d. Japanese Patent Publication No. JP8070300 to Shirakihara (Exhibit 1003)

e. Japanese Patent Publication No. JP9305155 to Hitachi (Exhibit 1009)

f. An article by Arnum entitled "The Universal Mailbox Arrives...sort of" (Exhibit 1005)

g. Systems for Automated Messages Reference Manual (Exhibit 1010)

h. A white paper by Crocker entitled "Standard for the Format of ARPA Internet Text Messages" (hereinafter referred to as "RFC 822," Exhibit 1011 (also Exhibit 2006))

i. First Declaration of John Friend (Exhibit 1004)

j. Substitute Second Declaration of John Friend (Exhibit 1031)

k. Deposition Transcript of John Friend (Exhibit 2080)

l. First Declaration of Gary S. Tjaden (Exhibit 2005).

m. *sendmail, by* Bryan Costales et al., O'Reilly & Assocs., Inc., Nov. 1993 (Exhibit 2025)

n. *Simon Says "Here's How!"*, User Manual, 1st ed., Feb. 1994 (Exhibit 2026)

o. U.S. Patent No. 5,941,956 to Shirakihara et al. (Exhibit 2082)

p. Lazaridis Substantive Motions 1-4

q. Eggleston Substantive Motions 1-2

r. Declaration of Gary P. Mousseau (Exhibit 2084)

s. Declaration of Herb A. Little (Exhibit 2085)

t. Exhibits 2059-2079 cited in the declarations of Gary Mousseau and Herb Little

u. Lotus ships cc:Mail Link to SMTP 2.0 (Exhibit 2087).

X. Conclusion

118. I declare that all statements made herein of my knowledge are true and that all statements made on information and belief are believed to be true and that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and may jeopardize the validity of the patent application to which they are directed or any patent issuing thereon.

119. In signing this declaration, I understand that the declaration will be filed as evidence in a contested case before the Board of Patent Appeals and Interferences of the United States Patent and Trademark Office. I acknowledge that I may be subject to cross examination in the case and that cross examination will take place within the United States. If cross examination is required of me, I will appear for cross examination within the United States during the time allotted for cross examination.

Dated: 2/26/10

Brad Karp